UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

I b

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/012,269	02/01/93	KWON	B

HM12/0620
SCHWEGMAN, LUNDBERG WOESSNER & KLUTH,PA
P.O. BOX 2938
MINNEAPOLIS MN 55402

EXAMINER	
BRANNOCK,M	
ART UNIT	**PAPER NUMBER**
1646	37

DATE MAILED: 06/20/00

06/20/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
08/012,269	Kwon, BS
Examiner	**Group Art Unit**
Michael Brannock, Ph.D.	1646

☒ Responsive to communication(s) filed on *Feb 1, 2000*

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *1* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) *1-3 and 6-30* is/are pending in the applicat

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims *1-3 and 6-30* are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

Status of Application: Claims and Amendments

1. Claims 1-3 and 6-30 are pending.

2. Applicant is notified that the amendments put forth in paper 36, 4/6/00.

Election/Restriction

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-3, 22 and 28-30, drawn to polynucleotides, classified in class 536, subclass 23.5.

II. Claims 6-8 and 17-20, drawn to polypeptides and methods of detecting cell membrane ligands, classified in class 530, subclass 350.

III. Claims 9-12, drawn to a monoclonal antibodies and hybridomas, classified in class 530 , subclass 351.

IV. Claims 13-16 and 21, drawn to a method of inducing or enhancing T-cell proliferation, classified in class 514, subclass 2.

V. Claims 23-27, drawn to a method for detecting a nucleic acid, classified in class 435, subclass 6.

4. The inventions are distinct, each from the other because of the following reasons:

Although there are no provisions under the section for "Relationship of Inventions" in M.P.E.P. § 806.05 for inventive groups that are directed to <u>different</u> products, restriction is

deemed to be proper because these methods appear to constitute patentably distinct inventions for the following reasons: Groups I, II and III are directed to products that are distinct both physically and functionally and are therefore patentably distinct. Further, the protein of Group II can be prepared by processes which are materially different from recombinant DNA expression of Group I, such as by chemical synthesis, or by isolation and purification from natural sources. Additionally, the DNA of Group I can be used other than to make the protein of Group II, such in gene therapy or as a probe in nucleic acid hybridization assays of Group V. The protein of Group II can be used in materially different methods other than to make the antibody of Group III, such as in therapeutic or diagnostic methods (e.g., in screening). Finally, although the antibody of Group III can be used to obtain the DNA of Group I, it can also be used in materially different methods, such as in various diagnostic (e.g., in as a probe in immunoassays or immunochromatography), or therapeutic methods as in Group IV.

Although there are no provisions under the section for "Relationship of Inventions" in M.P.E.P. § 806.05 for inventive groups that are directed to different methods, restriction is deemed to be proper because these methods appear to constitute patentably distinct inventions for the following reasons: Groups II, IV and V are directed to methods that are distinct both physically and functionally, require divergent starting materials, accomplish different goals, and are not required one for the other. Group II requires a method to detect or identify ligands of a polypeptide, which is not required by any of the other groups. Group IV requires methods of

enhancing T-cell proliferation, which is not required by any of the other groups. Group V requires a method of DNA hybridization, which is not required by any of the other groups.

The polynucleotides of Group I are related to the methods of Groups II and V as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the polynucleotides of Group I are patentably distinct from each of the methods of Groups II and V because the polynucleotides of Group I can be used in ways that are materially and functionally different than each of the methods because, as discussed above, each of the methods of Groups II and V are materially and functionally distinct from the others. Furthermore, the polynucleotides of Group I and the methods of Group IV are patentably distinct because one is not required for the use of the other.

The polypeptides of Group II are related to the methods of Groups IV as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the polypeptides of Group II are patentably distinct from the methods of Group IV because the polypeptides of Group II can be used in ways that are materially and functionally distinct from those of Group IV such as in a

method to produce the antibodies of Group III. Furthermore, the polypeptides of Group II and the method of Group V are patentably distinct because one is not required for the use of the other.

The antibodies of Group III are related to the methods of Groups II and IV as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the antibodies of Group III are patentably distinct from each of the methods of Groups II and IV because the antibodies of Group III can be used in ways that are materially and functionally different than each of the methods because, as discussed above, each of the methods of Groups II and IV are materially and functionally distinct from the others. Furthermore, the antibodies of Group III and the method of Groups V are patentably distinct because one is not required for the use of the other.

Therefore, a search and examination of all the groups in one patent application would result in an undue burden, since the searches for the groups are not co-extensive, the classification is different, and the subject matter is divergent.

5. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Brannock, Ph.D., whose telephone number is (703) 306-5876. The examiner can normally be reached on Mondays through Thursdays from 8:00 a.m. to 5:30 p.m. The examiner can also normally be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz, Ph.D., can be reached at (703) 308-4623.

Official papers filed by fax should be directed to (703) 308-4242. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

MB

June 17, 2000

ELIZABETH KEMMERER
PRIMARY EXAMINER